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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/752,898  
Filing Date: January 06, 2004  
Appellant(s): BUCHANAN, BRETT J.

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Eric D. Jorgenson  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 5/22/09 appealing from the Office action mailed 8/6/08.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

1022113	Smith	4-1912
4260635	Fisher	4-1981
6238715	Baikie	5-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the appellant regards as his invention.

- Claims 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.
  - Claim 5 is rejected due to the phrase “the cat” as it lacks antecedent basis and therefore it is unclear if “the cat” is with respect to “the animal” of independent claim 1, or with respect to only a cat being able to access the edible material by biting or clawing the shell.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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- Claims 1, 2, 5-10, 13, 19, 21-23, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (4260635) in view of Smith (1022113).

Fisher teaches an animal food toy that is shaped and includes multiple layers of edible materials encased by a shell for oral interaction with the animal (col. 4 line 11). The edible layers can be made of food components such as those animal foods currently used and known and are preferably in a dry, shelf-stable form such as dried meats, dried fish, fish meal, fish flour, cereals, fruits, etc., with or without food additives or supplements such as vitamins, minerals, medicinals, etc (col. 4 lines 11-24), where at least one underlying layer comprises multiple layers of a plurality of different edible materials (col. 3 lines 25-28, col. 9 lines 22-24). The layered product could employ as many layers as desired with the combinations herein being infinite such as 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, or more layers (col. 9 lines 22-24), where the outside layer can be viewed as the shell. Each layer may or may not include safely ingestible structure supporting fibers (abstract), where the binding material releases layer materials upon penetration (col. 4 lines 9-11) and the layers may be formed concentrically around a core by dipping the core repeatedly in rawhide or collagen fiber containing pet food (col. 2 lines 61-65), where the binding agent provides a time release property (col. 4 line 11).

In addition, the pet food can be built up to yield a product with different thickness layers, where the chew-resistance or hardness of the product could be a function of "the pressure employed in compacting the product" (col.2 line 25). With respect to claim 13 it is noted that all of the layers are edible thus positively teaching the inner edible material in the form of one or more edible objects.

Fisher continues by teaching that the shell maintains freshness of underlying layers (col. 4 lines 12-25), which gradually wears away (col. 1 lines 60-62) so as to release inner edible material upon penetration (col. 4 lines 1-10). With respect to claim 21 it is noted that the homogeneous mixture is taken with respect to figures 1 and 2, as the shell houses, and encases the mixture within. Further with respect to figure 1, Fisher positively teaches the edible material exhibiting a marbling effect (inner core labeled hard), and that the shell includes at least one edible nodule.

Fisher however is silent with respect to specifically teaching the toy for a cat, and that the edible material further includes catnip.

Smith teaches a “device in the form of a ball because a toy of such shape is easier for a cat to play with...” (pg. 2 col. 1 lines 7-9) Smith further teaches the “ball could be made either partially or entirely of a catnip compound,” (pg. 1 col. 1 line 49+) and “may include an exterior coating of the catnip compound,” (pg.1 col. 2 line 87+) “so that the cat may always be able to get the odor or taste or both of the catnip.” (pg. 1 col. 2 line 76+).

Therefore since Fisher teaches that the entire toy may be consumed, and further since Fisher teaches the addition of any “desired supplemental additives” for enticing the animal, one of ordinary skill in the art would have been motivated to combine the teachings and to have included catnip in the animal toy of Fisher, in the instance that the toy is desired to be specific for a cat, since both Fisher and Smith teach the positive solution of entertaining an animal by producing a toy that includes flavor agents, or inducements, since Fisher teaches an edible pet toy comprised of “known food” (col. 4 lines 19-24), and since Smith teaches a cat toy which includes catnip for its art recognized and appellants purpose of enticing a cat.

Thus it would have been obvious to one of ordinary skill in the art at the time of the invention by the appellant to have included catnip in the animal toy of Fisher, in the instance that the “animal” toy is desired to entice specifically a cat since Fisher teaches an edible pet toy comprised of “known food” (col. 4 lines 19-24) where Smith positively teaches enticing an animal, and specifically a toy which is enticing to a cat due to the odor or taste or both of the catnip.” (pg. 1 col. 2 line 76+).

In addition since both Fisher and Smith teach the positive solution of entertaining an animal by producing a toy that includes flavor agents, or inducements and since Fisher teaches an edible pet toy comprised of “known food” (col. 4 lines 19-24) where Smith positively teaches catnip for its art recognized and appellants purpose of enticing a cat, it would have further been obvious to one of ordinary skill in the art at the time of the invention by the appellant to include catnip in an animal which is specific to a cat, since providing a specific single edible material which is known in the art would be merely a matter of obvious choice which is dependent upon the specific animal which the toy is made for, and since MPEP 2144.07 states that the selection of a known material based on its suitability for its intended use supports a prima facie obviousness determination. In the instant case, Fisher teaches an edible pet toy comprised of “known food” (col. 4 lines

19-24) where Smith positively teaches catnip for its art recognized and appellants purpose of enticing a cat.

In addition, since all the claimed elements were known in the prior art and one skilled in the art could have substituted or additionally provided catnip with no change in their respective functions, where combining the two methods, each of which is taught by the prior art to be useful for the same purpose of enticing animals to a toy, flows logically from their having been individually taught in the prior art (see MPEP 2144.06) with respect to specific animals such as cats and dogs, thereby yielding predictable results to one of ordinary skill in the art at the time of the invention

- Claims 1, 2, 5, 10, 13, 15, 16, 21-23, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baikie (6238715) in view of Smith (1022113).

Baikie teaches an animal food that is shaped and includes edible materials encased by a shell for oral interaction with the animal by biting (col. 1 lines 40-52). More specifically the underlying layer formed of the edible material comprises a binding material that provides consistency to retain form (col. 2 lines 40-53, col. 3 lines 16-24), where the binding materials release the layer material upon penetration (col. 2 lines 27-31). In addition the edible material includes an inducement (col. 2 lines 20-25), that the binding agent provides consistency and rigidity thereby resulting in a time release property (col. 2 lines 27-31), where the edible material is a gel or a paste which is released through one or more holes in the shell (fig. 1, col. 3 lines 8-9) such that distortion causes the inner edible material to be released (col. 2 lines 27-31).

In addition, Baikie teaches mixing the edible material and binding material into a homogeneous mixture of an inducement and at least one of a nutrient or a treatment (col. 2 lines 40-53), forming an outer shell for housing the homogeneous mixture (col. 2 lines 6-64), and encasing the edible material within the shell (col. 3 lines 6-9), where the edible material can be replaced through a hole in the outer shell (col. 3 lines 6-8).

Baikie however is silent with respect to specifically teaching the toy for a cat, and that the edible material further includes catnip.

Smith teaches a “device in the form of a ball because a toy of such shape is easier for a cat to play with...” (pg. 2 col. 1 lines 7-9) Smith further teaches the “ball could be made either partially or entirely of a catnip compound,” (pg. 1 col. 1 line 49+) and “may include an exterior coating of the catnip compound,” (pg.1 col. 2 line 87+) “so that the

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cat may always be able to get the odor or taste or both of the catnip.” (pg. 1 col. 2 line 76+).

Therefore since Baikie teaches that the entire toy may be consumed, and further since Baikie teaches the addition any number of flavors such as poultry fat (col. 2 lines 51-52) and peanut butter, or bacon (col. 4 lines 5-7) for enticing the animal, one of ordinary skill in the art would have been motivated to combine the teachings and to have included catnip in the animal toy of Baikie, in the instance that the toy is desired to be specific for a cat, since both Baikie and Smith teach the positive solution of entertaining an animal by producing a toy that includes flavor agents, or inducements, where Baikie teaches an edible pet toy comprised a component which is specific to initially attracting the animals attention and maintaining this attraction (col. 2 lines 19-25) where a component thereof is poultry fat, which would provide inducement to a cat as does catnip as is taught by Smith.

Thus it would have been obvious to one of ordinary skill in the art at the time of the invention by the appellant to have included catnip in the animal toy of Baikie, in the instance that the “animal” toy is desired to entice specifically a cat since Baikie teaches the addition any number of flavors (col. 4 lines 5-7) for enticing the animal, where one of the components is specifically poultry fat which would provide inducement to a cat, and since Smith positively teaches catnip for its art recognized and appellants purpose of enticing a cat, thus providing an animal toy which is specific to a cat due to this known enticement.

It would have further been obvious to one of ordinary skill in the art at the time of the invention by the appellant to include catnip in an animal which is specific to a cat, since Smith specifically teaches the toy with respect to enticing a cat due to the catnip (pg. 1 lines 10-16) and thus providing a specific single edible material which is known in the art would be merely a matter of obvious choice which is dependent upon the specific animal which the toy is made for, and since MPEP 2144.07 states that the selection of a known material based on its suitability for its intended use supports a prima facie obviousness determination. In the instant case, Baikie teaches an edible pet toy comprised of a component which is specific to initially attracting the animals attention and maintaining this attraction (col. 2 lines 19-25), where Smith positively teaches catnip for its art recognized and appellants purpose of enticing a cat.



In addition, since all the claimed elements were known in the prior art and one skilled in the art could have substituted or additionally provided catnip with no change in their respective functions, where combining the two methods, each of which is taught by the prior art to be useful for the same purpose of enticing animals to a toy, flows logically from their having been individually taught in the prior art (see MPEP 2144.06) with respect to specific animals such as cats and dogs, thereby yielding predictable results to one of ordinary skill in the art at the time of the invention.

### ***Response to Arguments***

#### **Argument A:**

Claim 5 is rejected due to the phrase “the cat” as it lacks antecedent basis and therefore it is unclear if “the cat” is with respect to “the animal” of independent claim 1, or with respect to only a cat being able to access the edible material by biting or clawing the shell.

#### **Argument B:**

It is initially noted that Fisher teaches an "animal" toy, and thus Fisher is not limited to only dogs, but to "animals" in general which includes cats. Dogs are merely a preferred specific example with respect to the broadly claimed species, “animals”. It is further noted that catnip is a type of mint, which produces an odor. Therefore one of ordinary skill would expect dogs to further be attracted to catnip since dogs are attracted to scents given off by edible products.

With respect to appellant’s arguments against Fisher that the recitation in the independent product claims 1, 10, and 19 that the animal toy includes catnip thus limiting appellant’s product to only cats is merely an intended use of the claimed product. Respectfully, attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. Therefore with respect to product claims 1, 10 and 19 Fisher is merely silent with respect to teaching the addition of catnip in the animal toy.

It is further noted that the method of independent claim 21 does not claim a cat toy, but merely an edible toy for an animal which includes an inducement.

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It is noted that Fisher teaches the addition of any known additives (col. 4 lines 21-24) for enticing an animal, in addition to teaching an edible pet toy comprised of “known food” (col. 4 lines 19-24), where Smith teaches a cat toy which includes catnip for its art recognized and appellants purpose of enticing a cat. Fisher specifically teaches a certain concept, namely an edible pet toy of any size no matter how big or small, and a method of making the edible pet toy which includes the addition of any known additives (col. 4 lines 21-24) for enticing the animal, which is a function especially pertinent to the invention at hand, where Smith is used as a teaching reference, for teaching a cat toy which includes catnip for its art recognized and appellants purpose of enticing specifically a cat.

Fisher teaches an animal toy which is merely silent with respect to the addition of catnip, however Fisher does teach an animal toy which may be provided with the addition of any “desired supplemental additives” (col. 4 lines 21-24). Thus since a person of ordinary skill has good reason to pursue the known options within his or her technical grasp for providing a more appealing food product to a specific animal, such as a cat, and since Smith teaches that catnip is an attracting compound due to the sensory qualities it provides a cat (pg. 1 lines 75-80), providing specifically an additive which is catnip would flow logically thus further providing predictable results, and anticipated success, with respect to an animal toy as taught by Fisher which is specifically desired to be enticing too a cat.

In response to appellant’s argument that Fisher and Smith are nonanalogous art since Fisher does not teach the toy being specific for a cat, it is noted that it has been held that a prior art reference must either be in the field of appellant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the instant case Fisher teaches the addition of any known additives (col. 4 lines 21-24) for enticing an animal, in addition to teaching an edible pet toy comprised of “known food” (col. 4 lines 19-24), where Smith teaches a cat toy which includes catnip for its art recognized and appellants purpose of enticing a cat. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, with respect to appellant’s argument that the product of Fisher can not be adapted for use with a cat, and are thus non-analogous are, it is noted that Fisher specifically teaches a certain concept, namely an edible pet toy comprised of “known food” (col. 4 lines 19-24), of which the size and

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shape of the system will depend upon many factors, "such as size of the dog", where more importantly it is noted that Fisher does not limit the toy to dogs by merely provides dogs as an example. Thus although appellant argues "it is well known that cats do not have the same teeth and jaw strength capabilities", since Fisher acknowledges that dogs come in many different sizes (col. 4 lines 5-6), where some dogs such as a Chihuahuas are smaller than and/or the same size as some cats, Fisher therefore, is a pertinent reference, because it teaches an edible pet toy of any size no matter how big or small, and a method of making the edible pet toy which includes the addition of any known additives (col. 4 lines 21-24) for enticing the animal. It is further respectfully noted that animal chew toys in general are commonly made in different sizes, shapes and materials to compensate for animal size, breed, chewing frequency, or durability, which is a function especially pertinent to the invention at hand. Smith is used as a teaching reference, for teaching a cat toy which includes catnip for its art recognized and appellant's purpose of enticing specifically a cat.

In addition, respectfully it is noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case the claims do not teach a specific amount of catnip, a specific shape or desired numerical size with respect to the claimed product and thus with respect to appellant's argument that a considerable amount of engineering and redesigning would be required. In the instant case it is the Examiner's position that merely providing catnip in the system of Fisher would have been obvious to one of ordinary skill in the art looking to provide a specific enticement or an additional enticement to a cat, since Fisher teaches the addition of any known additives (col. 4 lines 21-24) for enticing the animal, in addition to teaching an edible pet toy comprised of "known food" (col. 4 lines 19-24), where Smith teaches a cat toy which includes catnip for its art recognized and appellants purpose of enticing a cat. It is further respectfully noted that although Fisher is silent with respect to teaching catnip, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it is noted that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the

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instant case, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Fisher teaches the addition of any known additives (col. 4 lines 21-24) for enticing the animal, in addition to teaching an edible pet toy comprised of "known food" (col. 4 lines 19-24), where Smith teaches a cat toy which includes catnip for its art recognized and appellants purpose of enticing a cat.

It is further noted that the recitation in the claims that the binding material is "for releasing layers upon penetration" is merely an intended use of the claimed product. Respectfully attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim.

It is further noted that Fisher does not teach "no release of inner edible material upon penetration" as is argued by appellant. It is noted that if the animal toy as taught by Fisher was not capable or desired to provide any degree of release of the edible material within, then one would wonder why Fisher teaches the incorporation of flavoring, medicine or other food additives, such as with respect specifically to example 5 which teaches the addition of an "enzyme capable of removing plaque and/or tartar" from an animals teeth. Thus in order for the plaque and/or tartar to be removed from the teeth the enzyme must be in contact therewith and thus Fisher does positively teach the limitation as the enzyme in this instance must be released in order to contact the teeth.

Further with respect to appellant's argument that the binding material and the edible material are different and that only the edible material is released, it is noted that independent claim 1 states "the binding material releases layer material upon penetration, and the edible material including catnip", which does not positively recite providing the two in separable fashion or that they are separate. Similarly, regarding independent product claim 10, it is noted that the "inner edible material comprises a binding material" and thus there is no positive recitation of providing the two in separable fashion or that they are separate. Similarly independent product claim 19 states "inner edible material include an edible binding material" and thus there is no positive recitation of providing the two in separable fashion or that they are separate. It is further noted that independent method claim 21 teaches the edible material and the binding material being provided in a "homogenous mixture", thus there is no positive recitation of providing the two compounds in separable fashion or that they are separate. Therefore with respect to appellant's

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arguments that only the edible material is released and specifically that the binding material effects the release of the inner edible material, it is respectfully noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to appellant's argument that Fisher does not teach "maintains freshness of underlying material" of claim 19, it is initially noted that Fisher positively teaches a shell as is claimed and an inner edible material as claimed and further in light of Fisher positively teaching that "preservation is not a problem" (col. 4 lines 14-15) and that "no packaging is needed" (col. 3 line 58), Fisher positively teaches "maintains freshness of underlying material" since Fisher teaches a shell.

With respect to appellant's argument that Fisher does not teach that the shell "gradually wears away", Fisher does teach altering the chew resistance of the multi-layer animal toy, where it is noted that claim 29 does not provide a time period with respect to "gradually wears away" and thus by altering the chew resistance you are providing an animal product which "gradually wears away" due to an animals interaction therewith since Fisher specifically desires a product which precludes the animal from "wolfing" the toy down (col. 3 lines 47-50).

#### **Argument C:**

With respect to appellant's arguments against Baikie, it is once again noted that the recitation in the independent product claims 1, 10, and 19 that the animal toy includes catnip thus limiting appellant's product to only cats is merely an intended use of the claimed product. Respectfully, attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. Therefore with respect to product claims 1, 10 and 19 Baikie is merely silent with respect to teaching the addition of catnip in the animal toy. It is further noted that the method with respect to independent method claim 21 does not teach a cat toy, but merely an edible toy for an animal which includes an inducement, where method claim 22 teaches the inducement stimulates a cat.

It is further noted that catnip is a type of mint, which produces an odor. Therefore one of ordinary skill would expect dogs to further be attracted to catnip since dogs are attracted to scents given off by edible products.

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Baikie teaches an animal toy which is merely silent with respect to the addition of catnip, however Baikie does teach an animal toy which may be provided with the addition of attractant such as poultry fat (col. 2 lines 21-24). Thus since poultry fat would be an attractant to a cat, and since catnip is a type of mint, and since a person of ordinary skill has good reason to pursue the known options within his or her technical grasp for providing a more appealing food product to a specific animal, one of ordinary skill would expect dogs to further be attracted to catnip since dogs are attracted to scents given off by edible products. Therefore it is respectfully noted that since MPEP 2144.07 states that the selection of a known material based on its suitability for its intended use supports a prima facie obviousness determination and since Baikie teaches an edible pet toy comprised of a component which is specific to initially attracting the animals attention using poultry fat, where it is noted that cats are attracted to the scent of chicken, and maintaining this attraction (col. 2 lines 19-25), it would have been obvious to one of ordinary skill in the art since Smith positively teaches catnip for its art recognized and appellants purpose of enticing a cat, since all the claimed elements were known in the prior art and one skilled in the art could have substituted or additionally provided catnip with no change in their respective functions, where combining the two methods, each of which is taught by the prior art to be useful for the same purpose of enticing animals to a toy, flows logically from their having been individually taught in the prior art (see MPEP 2144.06) with respect to specific animals such as cats and dogs, thereby yielding predictable results to one of ordinary skill in the art at the time of the invention.

With respect to appellant's argument that the binding material and the edible material are different and that only the edible material is released, it is noted that independent claim 1 states "the binding material releases layer material upon penetration, and the edible material including catnip", which is taken to teach the desire to release both. Regarding independent product claim 10, it is noted that the "inner edible material comprises a binding material" and there is no positive recitation of separating the two during access thereto. Similarly independent product claim 19 states "inner edible material include an edible binding material" and there is no positive recitation of separating the two during access thereto. It is further noted that independent method claim 21 teaches the edible material and the binding material being provided in a "homogenous mixture", therefore with respect to appellant's arguments only the edible material is released, it is respectfully noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case Baikie teaches a shell, an edible material encased by shell, and a binding layer.

In response to appellant's argument that Baikie and Smith are nonanalogous art since Baikie does not teach the toy being specific for a cat, it respectfully noted that it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the instant case Baikie teaches a certain concept, namely an edible pet toy comprised of inducements for initially attracting the animals (col. 2 lines 21-24) and a shell. Thus although appellant argues "it is well known that cats do not have the same teeth and jaw strength capabilities" and thus the toy as taught by Baikie would not be "chewable" by cats, it is noted that the features upon which appellant relies (i.e., that the edible is chewed) is not recited in the rejected claim(s). Respectfully it is noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further with respect to appellant's argument that "it is well known that cats do not have the same teeth and jaw strength capabilities" as dogs, it is noted that different sized cats, differently aged cats, etc. would also have different jaw strength capabilities and thus it is noted that the features upon which appellant relies (i.e., that the edible is specific to teeth and jaw strength capabilities of cats) is not recited in the rejected claim(s).

In this case, the size and shape of the chew will depend upon many factors, since it is further respectfully noted that animal chew toys in general are commonly made in different sizes, shapes and materials to compensate for animal size, breed, chewing frequency, or durability, which is a function especially pertinent to the invention at hand. Baikie therefore, is a pertinent reference, because it teaches an edible pet toy of any size no matter how big or small, and a method of making the edible pet toy which includes the addition of known additives for enticing the animal. Smith is used as a teaching reference, for teaching a cat toy which includes catnip for its art recognized and appellant's purpose of enticing specifically a cat.

With respect to appellant's argument that Baikie is silent with respect to teaching "the shell includes one or more holes" appellant is urged to figure 1, reference number 30 which clearly illustrates a hole, and further to column 3 lines 6-9, which teaches a hole, i.e. allowing the desired inner material to flow into the product.

With respect to appellant's argument that Baikie is silent with respect to teaching "encasing the edible", appellant is initially urged to figure 1, which clearly illustrates a shell (ref. 24) encasing filling

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30, where it is further noted that claim 21 does not require complete encasing being provided by a shell which encases all surfaces thereof, but merely encasing as is taught by Baikie.

With respect to appellant's argument that Baikie is silent with respect to the limitation of claim 26 that a hole is formed in the outer shell such that the edible material can be replaced there through, it is noted that the phrase "such that the edible material can be replaced there through" does not positively recite actually replacing the edible material, and thus with respect to claim 26, appellant is urged to figure 1, reference number 30 which clearly illustrates a hole, and further to column 3 lines 6-9, which teaches a hole, i.e. allowing the desired inner material to flow into the product.

### ***Oath/Declaration***

Regarding appellant's declaration and the testimonials provided which speak to the novelty of the appellant's invention, it is respectfully noted that these statement amount to an affirmation that the affiant has never seen the claimed subject matter before in market by another. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

The Declaration further states that the claimed subject matter solved a problem that was long standing in the art. However, it is respectfully noted that there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem, See MPEP § 716.04, where appellant has provided no statistical data and relies upon statements which amount to an affirmation that the appellant has never seen the claimed subject matter before by another and an affirmation that catnip provides an inducement as was taught by Smith in 1912. However, respectfully it is noted that this is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

It is further noted that since Fisher and Baikie teach the claimed product and Smith specifically teaches catnip as an attractant to cats, one of ordinary skill in the art would not expect the instant claims to perform differently than the prior art product, the claimed method is not patentably distinct from the prior art method (See MPEP 2144.04 IV A). Where the general conditions of a claim are disclosed in the prior art, it is further respectfully noted that the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine, the most appealing flavoring or inducement for a specific animal, in the instant case such as providing catnip as is taught by Smith.



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In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

In summary, the claims are directed to an edible pet toy comprising a shell, a layer of an edible material which is an attractant, and a binding agent all of which are positively taught by Fisher and Baikie. Thus the only limiting element that is not taught by primary reference Fisher or primary reference Baikie is the addition of catnip. Therefore since both recognize providing an attractant for an animal, where Smith teaches a cat toy which includes catnip for its art recognized and appellant's purpose of acting as an attractant compound due to the sensory qualities it provides a cat (pg. 1 lines 75-80), and since all the claimed elements were known in the prior art and one skilled in the art could have substituted or additionally provided catnip with no change in their respective functions, combining the two, each of which is taught by the prior art to be useful for the same purpose of enticing animals to a toy, flows logically from their having been individually taught in the prior art with respect to specific animals such as cats and dogs, thereby yielding predictable results and anticipated success, with respect to an animal toy to one of ordinary skill in the art at the time of the invention in light of Fisher, Baikie and Smith.

### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Steven Leff/

Examiner, Art Unit 1794

/Rena L. Dye/

Supervisory Patent Examiner, Art Unit 1794

Conferees:

/Rena L. Dye/

Supervisory Patent Examiner, Art Unit 1794

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/Jennifer Michener/

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